

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-20 were in this application, claims 5 and 9 have been cancelled, and claims 1, 6, 7, 10, 11 and 15-20 have been amended.

Claim 1 has been amended to include the limitations of claims 5 and 9 therein. Consequently, the rejection of claims 1-8 and 12-17 is rendered moot.

Claims 9-11 and 18-20 were rejected under 35 U.S.C. §103(a) as being obvious over Nordstrom in view of Furuya et al and further in view of Meives.

It has clearly been established that obviousness cannot be found by combining the teachings of prior art references to produce the claimed invention absent some teaching, suggestion or incentive to do so. ACS Hospital Sys. Inc. v. Montefiori Hospital, 221 U.S.P.Q. 929 (Fed. Cir. 1984). It is to be noted that "citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining a reference in such a manner as to arrive at the claimed invention". Ex parte Hiyamizu, 10 U.S.P.Q. 1993 (POBA 1988). Also, "both the suggestion and the expectation of success must be found in the prior art, not in the applicants' disclosure". In re Dow Chemical Col., 837 F. 2d 469 (Fed. Cir. 1988).

It is not within the frame work of 35 U.S.C. § 103 to pick and choose from the prior art only so much as will support a holding of obviousness to the exclusion of other parts necessary for a full appreciation of what the prior art teaches or suggests, as hindsight is not the test. In re

Wesslau, 147 U.S.P.Q. 391 (CCPA 1965). It has been held improper to use the applicants' disclosure as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the results of the claims sought to be invalidated. Orthopedic Equip. Co., Inc. v. United States, 217 U.S.P.Q. 193 (Fed. Cir. 1983).

The applicants' invention is directed to transferring units for groups of rolls. In transferring such groups of rolls, problems can develop which results in misalignment which can cause defective packaging of the group of rolls, with a consequent reduction in packaging efficiency and speed. The invention also allows simple and rapid equipment change over when the size of the groups of rolls changes (P. 5, L. 19-33; P. 12, L. 8-21).

The particular arrangement of components according to amended claim 1 provides a transferring unit combining the first conveyor (50), second conveyor (150) with the third and fourth conveyors (350, 450) to resolve the problems of the prior art unit as the conveyors, operating at a cumulated speed can transport the group of rolls (P) With a film (6) wrapped around it but not yet fixed without the rolls or film moving relative to each other, preventing displacement of the rolls or mis-aligned packaging.

No such combination of conveying units is found in the prior art and it is only with hindsight that the examiner is picking and choosing elements to find the applicants' invention obvious, which is improper.

In addition, the conveyors of 18a and 18b of Meives attempt to realign stacks of sheets already displaced and are incapable of providing the side support of the group of rolls during travel to avoid such problems in the first place. Further, the examiner referred to the "upper 7 supporting means" of Furuya et al, and this element is only an arm that drives a rear pusher 7,

and it is incapable of directly supporting a package during transport.

Consequently, as there is no teaching or suggestion for providing the transport unit of amended claim 1, claim 1 and the claims dependant therefrom are not obvious over the cited art.

Based on the above amendments and remarks, favorable consideration and allowance of the application is requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William J. Sapon", written over a horizontal line.

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